

### **REMARKS**

Claims 1-10 remain pending in the application.

#### **Objection to the Drawings**

The Office Action AGAIN objected to the Figures 1 and 2 as allegedly lacking a legend of "Prior Art". In particular, the Examiner points to the language in the Applicant's specification at page 6, line 22 that discloses an "existing" system.

Figures 1 and 2 are clearly disclosed within Applicant's specification as being embodiments of the Applicant's invention, i.e., Figures 1 and 2 are **NOT** prior art.

Moreover, the full passage that the Examiner points to in the Applicant's specification discloses "Fig. 2 shows exemplary existing user plane location service signaling based on the user plane location service accordance shown in Fig. 1." The word "existing" from Applicant's page 6, line 22 taken within context of the entire sentence references using existing user plane location service signaling in accordance with Applicant's disclosure shown in Figure 1. Thus, the word "existing" from Applicant's page 6, line 22 does **NOT** disclose Fig. 1 and Fig. 2 as prior art **BUT** a novel use of such existing signaling information.

#### **Objection of the Disclosure**

The Office Action objected to the Applicant's disclosure at page 1, line 20's reference to a "Control Plane". The Examiner alleges that the disclosed "Control Plane" should be changed to a "User Plane".

Applicants Background of Related Art at page 1, line 20 is amended herein as suggested by the Examiner.

**35 USC 112 Second Paragraph Rejection of Claims 1, 2, 4-8, 10, 13, 15-19 and 27-52**

The Office Action rejected claims 1-10 as allegedly being indefinite under 35 USC 112.

In particular, the Examiner rejected claims 1 and 6 as allegedly indefinite for reciting the phrase “capable”. The Applicant respectfully disagrees.

The phrase “capable” for a system or method positively recites a capability, with patent infringement not dependent on actual implementation. The Examiner requests that claims 1 and 6 be amended to recite “is” being transmitted instead of “capable” of being transmitted. However, the Examiner’s requested change would require actually implementation of the claimed features to infringe Applicant’s claimed features. The Applicant is unaware of any support for the Examiner’s contention that the phrase “capable” renders a claim indefinite. Nevertheless, to further prosecution claims 1 and 6 are amended herein to remove the word “capable” from the claims.

In particular, the Examiner rejected claims 1 and 6 as allegedly indefinite for reciting a “message tunneling mechanism”. The Applicant respectfully disagree.

The recited “message tunneling mechanism” is disclosed throughout Applicant’s specification. Hence, “claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation.’” MPEP § 2111.01 at 2100-37 (Rev. 1, Feb. 2000) (quoting In re Marosi, 218 USPQ 289, 292 (Fed. Cir. 1983)(emphasis in original)). With the claims being interpreted in light of the specification that clearly details the recited “message tunneling mechanism”, the recited “message tunneling mechanism” is clearly recited in claims 1 and 6.

In particular, the Examiner rejected claims 1 and 6 as lacking antecedent basis for the recited “a location service system”.

Claims 1 and 6 recite “a” location service system NOT “said” location service system. Thus, the recited “a location service system” does not require a previous recitation of a “system” as alleged by the Examiner.

**Claims 1-10 over Flynn in view of Havinis and Lam**

In the Office Action, claims 1-10 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent Application Publication No. 2004/0229632 to Flynn et al. ("Flynn") in view of U.S. Patent No. 6,219,557 to Havinis ("Havinis"), and further in view of U.S. Patent Application Publication No. 2003/0072318 to Lam et al. ("Lam"). The Applicant respectfully traverses the rejection.

Claims 1-10 recite a system and method of establishing a roaming interface between a home LCS manager of a home wireless carrier network and a visited LCS manager of a currently visited wireless carrier network; and directing IP connectivity over the roaming interface between a home LCS manager and a visited LCS manager over an Internet, through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network.

The Examiner acknowledged that Flynn fails to disclose directing IP connectivity over an Internet, through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network (See Office Action, page 4). The reason Flynn fails to disclose directing IP connectivity over an Internet, through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network is that Flynn fails to disclose or suggest a need for EITHER an IP connection OR a firewall to implement his invention. Thus, there would no suggest to modify Flynn with a IP connection OR a firewall, much less with an IP connection AND a firewall.

The Examiner acknowledged that Havinis discloses routing a data call through an Internet connection (See Office Action, page 4). However, claims 1-10 are amended herein to more clearly recite the claims features. Havinis disclosing routing calls over an Internet connection fails to disclose or suggest directing IP connectivity between a home LCS manager and a visited LCS manager, much less through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network, as recited by claims 1-10.

The Office Action relied on Lam to make up for the deficiencies in Havinis to arrive at the claimed features. In particular, the Examiner relied on Lam to disclose that “firewalls are well known in the art, are used as filtering devices to protect networks from unauthorized access, may be placed in various locations within networks, and that routers may be configured to accelerate packet forwarding through them.” and “that it is well known to use firewalls between home carrier networks and visited carrier networks (See Office Action, pages 4 and 5).

Lam appears to disclose use of firewalls. However, as amended herein Lam fails to disclose or suggest firewalls associated with a path between a home LCS manager and a visited LCS manager, much less disclose or suggest directing IP connectivity between a home LCS manager and a visited LCS manager over an Internet, through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network, as recited by claims 1-10.

Moreover, Lam's invention is directed toward sending data packets between various data networks across firewalls (Fig. 2). However, Lam fails to disclose or suggest any application to a wireless device while roaming, much less disclose or suggest use of firewalls with a system and method relying on a roaming interface, i.e., directing IP connectivity over the roaming interface between a home LCS manager and a visited LCS manager over an Internet, through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network, as recited by claims 1-10.


Thus, Flynn modified by the disclosure of Havinis and Lam would STILL fail to disclose or suggest a system and method of establishing a roaming interface between a home LCS manager of a home wireless carrier network and a visited LCS manager of a currently visited wireless carrier network; and directing IP connectivity over the roaming interface between a home LCS manager and a visited wireless carrier network over an Internet, through a firewall in a home wireless carrier network and through a firewall in a visited wireless carrier network, as recited by claims 1-10.

Accordingly, for at least all the above reasons, claims 1-10 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

**Conclusion**

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'William H. Bollman', written over a horizontal line.

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